Exhibit A:

Amendment After Final

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Confirmation No.: 3920
Bijan **TADAYON**, *et al.*	)	Group Art Unit: 3621
Serial No. 10/777,044	)	Examiner: Kucab, Jamie R.
Filed: February 13, 2004	)	
For: **METHOD AND APPARATUS FOR DYNAMICALLY ASSIGNING USAGE RIGHTS TO DIGITAL WORKS**	)	Date: June 14, 2010

AMENDMENT AFTER FINAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action mailed May 12, 2010, Applicants respectfully request reconsideration and allowance of the present application in view of the following amendments and remarks.

Amendments to the Claims begin on page 2 of this paper.

Remarks begin on page 10 of this paper.

AMENDMENTS TO THE CLAIMS

1. (Previously Presented) A method of dynamically assigning usage rights to digital content for use in a system having at least one repository, said method comprising:

specifying, using a processor, a usage right, the usage right comprising computer readable data stored on a recording medium, the data of the usage right specifying an authorized use of digital content and being enforceable by a repository;

determining, using a processor, a status of a dynamic condition; and

dynamically assigning, using a processor, the usage right to the digital content based on the status of the dynamic condition,

wherein access to the digital content is controlled by the repository through enforcement of the usage right assigned to the digital work.

2. (Cancelled)

3. (Original) The method of claim 1, wherein the usage right specifies a resolution of the digital content that is authorized for use by the user.

4. (Original) The method of claim 3, comprising:

determining a resolution for download of the digital content based on the status of the dynamic condition;

applying a sub-band decomposition algorithm to the digital content to create sub-images; and

combining the sub-images into a processed image of the determined resolution for downloading.

5. (Original) The method of claim 4, wherein said applying step comprises applying a wavelet decomposition algorithm to the digital content.

6. (Original) The method of claim 1, wherein the dynamic condition includes a time of day.

7. (Original) The method of claim 1, wherein the dynamic condition includes a load on a computer system used to distribute the digital content.

8. (Original) The method of claim 1, wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition.

9. (Original) The method of claim 1, wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition.

10. (Original) The method of claim 1, wherein the authorized use of the digital content includes at least one of an ability to print the digital content, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content, and

wherein the method comprises dynamically assigning based on the status of the dynamic condition the usage right specifying the at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content.

11. (Original) The method of claim 1, wherein the digital content includes textual content.

12. (Original) The method of claim 1, wherein the digital content includes audio content.

13. (Original) The method of claim 1, wherein the digital content includes video content.

14. (Original) The method of claim 1, wherein the digital content includes software.

15. (Original) The method of claim 1, comprising conducting the determining step in a continuous manner.

16. (Original) The method of claim 1, comprising conducting the determining step in a periodic manner.

17. (Previously Presented) The method of claim 1, further comprising distributing the digital content and wherein said determining step occurs contemporaneously with said distributing step.

18. (Currently Amended) A system for dynamically assigning usage rights to digital content and including at least one repository, said system comprising:

a processor ~~for specifying~~ programmed to specify a usage right, the usage right specifying an authorized use of digital content and being enforceable by a repository;

a processor ~~for determining~~ programmed to determine a status of a dynamic condition; and

a processor ~~for dynamically assigning~~ programmed to dynamically assign the usage right to the digital content based on the status of the dynamic condition,

wherein access to the digital content is controlled by the repository through enforcement of the usage right assigned to the digital work.

19-21. (Canceled)

22. (Previously Presented) The system of claim 18, wherein the usage right specifies a resolution of the digital content that is authorized for use by the user.

23. (Currently Amended) The system of claim 22, further comprising:

a processor ~~for determining~~ programmed to determine a resolution for download of the digital content based on the status of the dynamic condition;

a processor ~~for applying~~ programmed to apply a sub-band decomposition algorithm to the digital content to create sub-images; and

a processor for combining the sub-images into a processed image of the determined resolution for downloading.

24. (Currently Amended) The system of claim 23, wherein said processor ~~for applying~~ programmed to apply further applies a wavelet decomposition algorithm to the digital content.

25. (Previously Presented) The system of claim 18, wherein the dynamic condition includes a time of day.

26. (Previously Presented) The system of claim 18, wherein the dynamic condition includes a load on a computer system used to distribute the digital content.

27. (Previously Presented) The system of claim 18, wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition.

28. (Previously Presented) The system of claim 18, wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition.

29. (Currently Amended) The system of claim 18, wherein the authorized use of the digital content includes at least one of an ability to print the digital content, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content, and the system further comprises a processor ~~for dynamically~~ programmed to dynamically assign ~~assigning~~, based on the status of the dynamic condition, the usage right specifying at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content.

30. (Previously Presented) The system of claim 18, wherein the digital content includes textual content.

31. (Previously Presented) The system of claim 18, wherein the digital content includes audio content.

32. (Previously Presented) The system of claim 18, wherein the digital content includes video content.

33. (Previously Presented) The system of claim 18, wherein the digital content includes software.

34. (Currently Amended) The system of claim 18, further comprising a processor ~~for conducting~~ programmed to conduct the determining of the status of the dynamic condition in a continuous manner.

35. (Currently Amended) The system of claim 18, further comprising a processor ~~for conducting~~ programmed to conduct the determining of the status of the dynamic condition in a periodic manner.

36. (Currently Amended) The system of claim 18, further comprising a processor ~~for distributing~~ programmed to distribute the digital content and a processor for conducting the determining of the status of the dynamic condition contemporaneously with distribution of the digital content.

37. (Currently Amended) A device for enforcing usage rights assigned to digital content, said device comprising:

a repository for receiving the digital content;

a processor ~~for requesting~~ programmed to request use of the digital content; and

a repository for enforcing use of the digital content in accordance with a usage right specifying an authorized use of the digital content, wherein the usage right is dynamically assigned to the digital content based on a determined status of a dynamic condition.

38-39. (Cancelled)

40. (Previously Presented) The device of claim 37, wherein the usage right specifies a resolution of the digital content that is authorized for use by the user.

41. (Currently Amended) The device of claim 40, further comprising:

a processor ~~for determining~~ programmed to determine a resolution for download of the digital content based on the status of the dynamic condition;

a processor ~~for applying~~ programmed to apply a sub-band decomposition algorithm to the digital content to create sub-images; and

a processor ~~for combining~~ programmed to combine the sub-images into a processed image of the determined resolution for downloading.

42. (Currently Amended) The device of claim 41, wherein said processor ~~for applying~~ programmed to apply further applies a wavelet decomposition algorithm to the digital content.

43. (Previously Presented) The device of claim 37, wherein the dynamic condition includes a time of day.

44. (Previously Presented) The device of claim 37, wherein the dynamic condition includes a load on a computer device used to distribute the digital content.

45. (Previously Presented) The device of claim 37, wherein the usage right includes a fee charged for the digital content based on the status of the dynamic condition.

46. (Previously Presented) The device of claim 37, wherein the usage right includes a distribution right for the digital content based on the status of the dynamic condition.

47. (Previously Presented) The device of claim 37, wherein the authorized use of the digital content includes at least one of an ability to print the digital content, an ability to distribute the digital content, a number of times that the digital content can be used, and a resolution of the digital content, and the usage right specifies at least one of the ability to print the digital content, the ability to distribute the digital content, the number of times that the digital content can be used, and the resolution of the digital content.

48. (Previously Presented) The device of claim 37, wherein the digital content includes textual content.

49. (Previously Presented) The device of claim 37, wherein the digital content includes audio content.

50. (Previously Presented) The device of claim 37, wherein the digital content includes video content.

51. (Previously Presented) The device of claim 37, wherein the digital content includes software.

52. (Previously Presented) The device of claim 37, wherein the status of the dynamic condition is determined in a continuous manner.

53. (Previously Presented) The device of claim 37, wherein the status of the dynamic condition is determined in a periodic manner.

54. (Previously Presented) The device of claim 37, wherein the digital content is distributed and the status of the dynamic condition is determined contemporaneously with distribution of the digital content.

55. (Original) The method of claim 1, wherein the steps of specifying, determining, and assigning are carried out using the same processor.

56. (Currently Amended) The system of claim 18, wherein the processors ~~for specifying, determining, and assigning~~ programmed to specify, determine and assign are combined into a single processor.

57. (Original) The device of claim 37, wherein the repository for receiving and the repository for enforcing are combined into a single repository.

REMARKS

Claims 1, 3-18, 22-37, and 40-57 were pending in this application. By this amendment, claims 18, 23, 24, 29, 34-37, 41, 42, and 56 are amended and claims 2, 19-21, and 38-39 are cancelled. No new matter has been added. In view of the above amendments and the following remarks, Applicants request reconsideration and withdrawal of the outstanding rejections.

Claims 1, 3-18, 22-37, and 40-57 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to provide a written description of the claimed invention. However, in stating the bases for the rejection, the Examiner notes that "Applicant does not have support for such an arrangement." Accordingly, it is not clear whether the rejection is based on the written description requirement or the enablement requirement of the first paragraph of 35 U.S.C. § 112. Each basis noted by the Examiner for this rejection is addressed below.

a. The three recitations of using a processor (claim 1). paragraph [0020] of the specification states that, "server 200 is associated with distributor 120 and can be … a collection of computers. Also, paragraph [0030] states that, the functions "… can be accomplished by any party on any device." These portions of the specification are merely examples of disclosure that the invention was contemplated to be accomplished on one or more computing devices each having at least one processor.

b. a repository for receiving the digital content (claim 37). Applicant points to paragraphs [0009] and [0010] and the Abstract as providing support for a repository receiving digital content. Also, US Patent 5,634,012 clearly discloses such a repository. This US Patent is incorporated by reference into the disclosure of this application.

c. The three recitations of using a processor (claim 18). paragraph [0020] of the specification states that, "server 200 is associated with distributor 120 and can be … a collection of computers. Also, paragraph [0030] states that, the functions "… can be accomplished by any party on any device." These portions of the specification are

merely examples of disclosure that the invention was contemplated to be accomplished on one or more computing devices each having at least one processor.

d. The three recitations of using a processor (claim 23). paragraph [0020] of the specification states that, "server 200 is associated with distributor 120 and can be … a collection of computers. Also, paragraph [0030] states that, the functions "… can be accomplished by any party on any device." These portions of the specification are merely examples of disclosure that the invention was contemplated to be accomplished on one or more computing devices each having at least one processor.

e. a repository for enforcing the use of the digital content (claim 37). Applicant points to paragraphs [0009] and [0010] and the Abstract as providing support for a repository enforcing the use of digital content. Also, US Patent 5,634,012 clearly discloses such a repository. This US Patent is incorporated by reference into the disclosure of this application.

f. wherein access to the digital content is controlled by the repository through enforcement of the usage right assigned to the digital work (claims 1 and 18). Applicant points to paragraphs [0009] and [0010] and the Abstract as providing support. Also, US Patent 5,634,012 clearly discloses such a repository. This US Patent is incorporated by reference into the disclosure of this application.

Claims 1, 3-18, 22-37, and 40-57 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner notes that the three recitations of "using a processor" in claim 1 would have been unclear to one of skill in the art because it is unclear whether these are the same or different processors. It is clear, based on the disclosure, that this claim language can be interpreted as one processor or multiple processors. Such implementation of distributing tasks over processors or using a single processor is well known and would be apparent to one of skill in the art.

The Examiner also notes that the recitation of "being enforceable by a repository" would have been unclear. However, US Patent 5,634,012 clearly discloses this element of the invention

and thus would be well known to one of skill in the art. The Examiner admits that US Patent 5,634,012 teaches usage rights that are enforceable by a repository. However, the Examiner's definition of same is not consistent with the patent. US Patent 5,634,012 does not require a watermark be attached to a digital work for example.

The Examiner also notes that the recitation of "wherein access to the digital content is controlled by a repository" would have been unclear. However, US Patent 5,634,012 clearly discloses this element of the invention and thus would be well known to one of skill in the art.

The Examiner notes that the three recitations of "using a processor" in claims 18, 22-37, 40-54, 56, and 57 would have been unclear to one of skill in the art because it is unclear whether these are the same or different processors. It is clear, based on the disclosure that this claim language can be interpreted as one processor or multiple processors. Such implementation of distributing tasks over processors or using a single processor is well known and would be apparent to one of skill in the art.

Finally, with respect to U.S.C. § 112, the Examiner indicates that it is not clear whether the claims are intended to invoke U.S.C. § 112, paragraph 6. Claims 18, 23, 24, 29, 34-37, 41, 42, and 56 are amended herein to clarify this matter in accordance with option (b) set forth by the Examiner on page 6 of the Office Action.

Claims 1, 6, 8-18, 25, 27-37, 39, 43, and 45-57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stefik et al., U.S. Patent No. 5,638,443. In addition, claims 1, 3, 6-18, 22, 25-37, 39, 40, and 43-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik et al. in view of Grosh, U.S. Patent No. 6,195,646. Furthermore, claims 4, 5, 23, 24, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik, Grosh, and either Applicants' Admitted Prior Art or Cox et al., U.S. Patent No. 5,930,369. Applicants respectfully disagree and submit that none of Stefik, Grosh, Cox, or AAPA, taken alone or in combination, disclose or suggest the claimed invention. It is most interesting that the Examiner takes the position that the disclosure in the present case is inadequate, notwithstanding the incorporation by reference of US patent 5,634,012 but then rejects the claims based on US Patent

5,638,443 when the disclosure of these two patents is substantially identical. This gap in logic must be explained in order to sustain the rejections set forth in the Office Action.

The present invention is generally directed to a method, system and computer program product for dynamically assigning usage rights to digital works. See Abstract and at least paragraphs [0002, 0010, and 0029-0030] of the present specification. For example, a user employs a computer to download a digital work from a distributor's server. The server specifies a usage right authorizing use of the digital work that is enforceable by a repository. The server tracks dynamic conditions that may affect the usage right of the digital work. The server assigns the usage right to the digital content in accordance with the dynamic conditions. See paragraphs [0019-0021, 0029, and 0030] of the present specification.

Regarding Stefik, Applicants maintain their position that Stefik fails to disclose dynamically assigning a usage right to the digital content based on the status of the dynamic condition as is recited in the claims. Specifically, there is no disclosure of *assigning* usage rights based on dynamic conditions. Instead, the Stefik patent teaches that conditions can be part of a usage right and that the authorized use defined by the right can include conditions. The conditions of the Stefik patent govern how the digital content can be used after the usage right is assigned to the content. However, *such conditions do not relate to how the rights are assigned to content* in the Stefik patent.

The step of "assigning" usage rights is the step of tying the usage rights to an instance of content so that those rights will govern use of the content. Prior to assignment, rights do not govern use of content. The usage rights disclosed in the Stefik patent, including a manner of use and conditions, are assigned to content. See Figure 1 step 102 and column 6, lines 16-49 of the Stefik patent. That is, the content is created (step 101 of Figure 1) and usage rights are attached, i.e. assigned, to the content, and the combination of the content and the usage rights is deposited in a repository (step 102 of Figure 1). Conditions of the assigned rights can then be considered after assignment of the rights to govern use of the content.

In contrast, the claims in the present application recite that the usage rights are *assigned* based on the status of dynamic conditions. The terms "assigned" and "assignment," as used in

the present specification, clearly refer to the association between the rights and the content. Prior to assignment, the rights are not associated with the content. See paragraphs [0010 and 0029] of the present application, for example.

In making his rejection, the Examiner asserts that the Stefik patent dynamically assigns and determines using a computer system and/or instructions stored on a computer readable medium. For example, the Examiner asserts that Stefik discloses that Time 1455 can be a dynamic condition, and that rights are dynamically assigned based on this dynamic condition. However, while Stefik discloses that time may be a condition as discussed above, the conditions of the assigned right are only considered after the right has been assigned to the content.

Specifically, Applicants respectfully submit that the portions of Stefik referenced by the Examiner are not disclosing time as a dynamic condition, but rather describing time synchronization between repositories. The condition in this example here would be better described as "clock drift" or "clock synchronization" rather than "time". According to Stefik, if the "clock drift" is too large, the whole transaction is aborted. This is not a dynamic condition upon which assignment of rights is based because there is no transaction if the clocks of the two repositories are too far out of sync.

While discussing the time condition of Stefik, the Examiner states that "the copy right is governed by a variety of measured times, see C21 L32-47, and in this way rights assigned when a new copy of a digital work is created are based on time." However, the portions of Stefik relied upon by the Examiner is no way disclose that rights are assigned "when a new copy of a digital work is created are based on time," and the Examiner fails to point to any further section of Stefik that discloses that rights may be assigned in this fashion.

In addition to the time condition, the Examiner further asserts that Stefik discloses a dynamic copy count condition, and that are dynamically assigned based on this dynamic condition. Specifically, the Examiner asserts that "the ability of a repository to create another copy and assign it rights is governed by the copy-count for the copy right. If this is zero, a copy cannot be created. If this is greater than zero, a copy can be created." In other words, the copy-count controls the making of copies. If there is no copy-count left, no copies can be made.

Contrary to the assertions of the Examiner, this is not a dynamic assignment of rights, because, for example, there is no copy made if the copy-count is zero.

In an effort to overcome the deficiencies of Stefik, the Examiner asserts that Grosh discloses assigning usage rights based on a dynamic condition, such as pricing and purchase conditions. However, contrary to the assertions of the Examiner, the pricing structure in Grosh is already assigned to the work before distribution, and it is merely "calculated" at the time of distribution. The distributed work in Grosh has no usage rights attached to it, so there is no need for dynamically assigning rights at distribution time. Thus, Grosh fails to overcome the above-noted deficiencies of Stefik.

AAPA and Cox et al. also fail to overcome the above-noted deficiencies of Stefik and Grosh. For example, Cox et al. discloses a secure spread spectrum watermarking technique that embeds a unique identifier into the perceptually significant components of a decomposition of an image, an audio signal, or a video sequence, but fails to disclose or suggest dynamically assigning a usage right to the digital content based on the status of a dynamic condition. Cox et al. instead merely discloses a technique for inserting digital watermarks in a data file. There is no usage right in Cox et al.

In contrast to the disclosures of Stefik, Grosh, Cox, and the AAPA, the claimed invention provides that the usage rights are dynamically assigned to content based on dynamic conditions occurring before, or at the time of association of the rights with content.

Thus, for at least the above-stated reasons, Stefik fails to disclose each and every feature recited in claims 1, 6, 8-20, 25, 27-37, 39, 43, and 45-54, and thus, does not anticipate these claims. In addition, none of Stefik, Grosh, Cox et al., or the AAPA, taken alone or in combination, disclose, suggest, or render obvious the invention recited in claims 1, 3-20, 22, 23, 25-37, 39, and 40-54. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

The Examiner has defined many claim terms on page 14 of the Office Action based on dictionary definitions. However, in footnote 3 found on page 13 of the Office Action, the

Examiner cites the Brookhill case which correctly states that dictionary definitions are secondary to the intrinsic record and should not be used to contradict the intrinsic record. Applicants respectfully request that the Examiner rely instead on the specification to define claim terms. If the Examiner would like further clarification in this regard, Applicants request that the Examiner contact the undersigned.

For the reasons above, all of the pending claims are in condition for allowance and such allowance is solicited. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

NIXON PEABODY, LLP

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